

REMARKS

Applicant has carefully reviewed the Application in light of the Office Action dated December 2, 2004. Claims 1-20 are pending and stand rejected. Applicant added Claims 21-23. Applicant submits that no new matter has been added by these new claims. For the reasons provided below, Applicant submits that the pending claims are allowable over the cited references. Therefore, Applicant respectfully requests reconsideration and favorable action in this case.

Double Patenting Rejections

Claims 1-20 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over U.S. Patent No. 6,412,556. In the interest of expediting prosecution, Applicant has included a terminal disclaimer to overcome the rejection. However, Applicant respectfully disagrees that the claims of the present application are not patentably distinct from those of U.S. Patent No. 6,412,556. For example, Claims 24, 25, and 38 of the '566 patent recite extending blunt arms while the independent Claims 1 and 9 of the present application, in contrast, do not. Furthermore, Claim 23 from which Claims 24 and 25 of the '566 patent depend includes "resting the arms on a floor of the cavity," which is another limitation that Claims 1, 9, and 18 do not include. Such different limitations render the Claims 1, 9, and 18 patentably distinct from the claims of the '566 patent.

Section 102 Rejections

Claims 1-3, 9, 15, and 17 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 2,662,486 ("*Hillger*"). In addition, Claims 1-3 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 1,230,666 ("*Carden*"). Applicants respectfully submit that both *Hillger* and *Carden* fail to anticipate the rejected claims, as neither discloses each and every limitation of independent claims 1 or 9.

For example, independent Claim 1 recites, "positioning a downhole device having a fluid agitator into the fluid of the subsurface cavity." It is argued that the agitator 16 inserted in well

bore 1 as disclosed in *Hillger* and the agitator 10 inserted in a well bore as disclosed in *Carden* meet this limitation. Applicant submits that such an argument fails to consider each and every word of Claim 1. "All words in a claim must be considered in judging the patentability of that claim against the prior art." M.P.E.P. § 2143.03 (citing *In re Wilson*, 424 F.2d 1382, 165 U.S.P.Q. 494, 496 (C.C.P.A. 1970)). Claim 1 recites that the device be placed into the fluid of a "subsurface cavity." Both *Hillger* and *Carden* merely disclose a well bore. *Hillger*, Col. 1, Lines 51-53; *Carden*, lines 44-46. Accordingly, *Hillger* and *Carden* fail to anticipate Claim 1, and Applicant respectfully requests the rejections of claim 1 and its dependent claims 2 and 3 be withdrawn.

Independent Claim 9 recites a limitation that is similar, although not identical, to the limitation of Claim 1 discussed above. Therefore, *Hillger* and *Carden* fail to anticipate Claim 9 for reasons analogous to those discussed above in connection with Claim 1. Accordingly, Applicant respectfully requests the rejections of claim 9 and its dependent claims 15 and 17 be withdrawn.

Section 103 Rejections

Claims 4 and 8 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Carden* in view of U.S. Patent No. 3,378,069 ("*Fields*"). In addition, Claims 9, 10, and 14-17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Carden* in view of *Hillger* and *Fields*. As discussed above, *Hillger* and *Carden* fail to anticipate independent Claims 1 and 9. *Fields* fails to disclose the missing elements discussed above with respect to Claims 1 and 9. In fact, like *Hillger* and *Carden*, *Fields* merely discloses inserting its agitator members 188 in a well bore. Col. 2, Lines 50-52; Col. 12, Lines 32-37. Thus, the combination of *Carden* and *Hillger* or *Fields* fails to render Claims 4, 8, 9, 10, and 14-17 obvious, and Applicant respectfully requests the rejections to the claims be withdrawn.

New Claims

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Applicant submits that support for the new Claims 21-23 is at least provided at Page 8, Lines 22-25; Page 10, Lines 13-16; and Figures 2 and 3.

CONCLUSION

For the foregoing reasons, and for other reasons clearly apparent, Applicant respectfully submits that the Application is in condition for allowance.

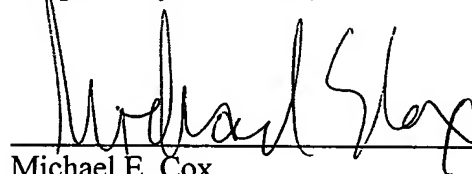
If the present application is not allowed and/or if one or more of the rejections is maintained, Applicant hereby requests a telephone conference with the Examiner and further requests that the Examiner contact the undersigned attorney to schedule the telephone conference.

A check in the amount of \$150.00 to cover additional claims fees is included herewith. Please apply any deficiencies or any other required fees or any credits to deposit account 06-1050, referencing the attorney docket number shown above.

Date: _____

3-2-05

Respectfully submitted,



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